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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,938	11/13/2003	Darshan Timbadia	128534-00701 (07027463)	9539
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MAYER BROWN LLP				
P.O. BOX 2828				
CHICAGO, IL 60690				
EXAMINER				
MOSSER, KATHLEEN MICHELLE				
ART UNIT		PAPER NUMBER		
3715				
NOTIFICATION DATE		DELIVERY MODE		
03/24/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipdocket@mayerbrown.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/712,938

Applicant(s)

TIMBADIA ET AL.

Examiner

Kathleen Mosser

Art Unit

3715

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 13 and 20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

Continuation of 11, does NOT place the application in condition for allowance because: Applicant first asserts that provisional application 60/425740 provides an enabling disclosure for the features of "upon failure of the testing station, the initial state object and the changed state object stored on the server are used to recreate the examination on the testing station at the point in the examination where the failure occurred" and "the user will not be penalized for the time that questions are not available". To support the first, the applicant cites several paragraphs of the provisional application which are directed to a recovery feature. The examiner acknowledges that the concept of a recovery function is mentioned in the provisional, however, the specifics, as claimed are not enabled. On page 6 in the second full paragraph, applicant cites a portion of the provisional application which combines information in the recovery. In this correlation, the applicant asserts that the "initial state object" correlates to the test question of the cited portion. However, there is no correlation in the provisional application which assigns this variable to the initial state object. The concept of an initial state object is completely void from the provisional application. Further, the applicant points to the location where the phrase "the user will not be penalized for the time the questions are not available" is recited verbatim in the provisional (page 7, last sentence of the response). Though this phrase is used in the provisional, it is used in a wholly different context than that in which it is claimed. As reproduced in the response (first full paragraph of page 7) this statement is made in combination with the calculation of the elapsed time of the exam. This section further describes a manner for accounting for transmission latency of questions to users and not penalizing the user for this period of time. This is not a function of the recovery process where an initial and changed state object are used to recreate the examination, as the step is claimed in connection with. For these reasons, though the provisional application makes general teachings of basic concepts, it does not describe the claimed invention in a manner which would allow one of ordinary skill in the art to make and use the invention. As such, the denial of priority based upon a lack of enabling disclosure in the parent application is maintained, and the reference to Ashley is deemed prior art.

Applicant further contends that the examiner's taking of official notice was improper (see page 8, first full paragraph of the response). In challenging the official notice the applicant has merely stated that the claimed feature is not of such notoriously character capable of instant and unquestionable demonstration. Aside from this general allegation the applicant has failed to show how the examiner's rationale, finding, or logic is improper. A mere allegation that a feature is not well-known fails to comply with the requirements of 37 CFR 1.111. See also MPEP 2144.03.

Applicant's arguments with respect to the Kershaw reference taken individually are considered moot, as the Ashley reference remains as prior art. Applicant's pre-emptive arguments for enablement of the instantly claimed invention are deemed moot, as no such rejection is currently of record.